

BL O/0734/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK REGISTRATION NO. UK801059447

FOR THE TRADE MARK:

KERN PHARMA

IN CLASS 5

AND IN THE MATTER OF TRADE MARK REGISTRATION NO. UK902943769

FOR THE TRADE MARK:



IN CLASS 5

BOTH IN THE NAME OF KERN PHARMA, S.L.

— AND —

APPLICATIONS FOR REVOCATION THEREOF
UNDER NUMBERS 507026 AND 507027 RESPECTIVELY

BY BIODKERN AG

Background and pleadings

1. UK comparable trade mark (EU) number 902943769, and UK comparable trade mark (IR) number 801059447, stand registered in the name of KERN PHARMA, S.L. (“KP”).¹ Details of the registrations are as follows:

“the Figurative Mark”	
Representation of the mark:	
UK comparable trade mark (EU) registration No.:	902943769 ²
Filing date:	15 November 2002
Registration Date:	28 January 2009
Goods for which it is registered: <u>Class 5</u> Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.	
“the Word Mark”	
Representation of the mark:	KERN PHARMA
UK comparable trade mark (IR) registration No.:	801059447 ³
Filing date:	21 October 2010
Registration Date:	18 February 2013

¹ Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) and all international trade mark registrations designating the EU, which were registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ and ‘comparable trade mark (IR)’, retain the same filing date, priority date / seniority dates (if applicable) and date of entry on the register as the EUTM / international (EU) mark from which it derives. See Schedule 2A (in relation to a ‘comparable trade mark (EU)’) and Schedule 2B (in relation to a ‘comparable trade mark (IR)’) of the Trade Marks Act 1994.

² This comparable registration derives from EUTM registration No. 2943769.

³ This comparable registration derives from the International Registration designating the EU, registration No. 1059447.

Goods for which it is registered:

Class 5

Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for dental fillings and dental impressions; disinfectants; pesticides; fungicides, herbicides.

2. On 20 February 2024, Biokern AG (“**Biokern**”) sought revocation of KP’s registrations under section 46(1)(a) of the Trade Marks Act 1994 (“the Act”)⁴ which alleges that a trade mark has not been used within the period of five years following the date of registration. The relevant five-year periods are as follows:

(1) The Figurative Mark

29 January 2009 to 28 January 2014, with an effective date of revocation of **29 January 2014**.

(2) The Word Mark

19 February 2013 to 18 February 2018, with an effective date of revocation of **19 February 2018**.

3. KP denies the claims made, submitting that it has made genuine use of the contested marks, for all of the goods covered by the registrations, within the relevant periods.

4. KP filed evidence and Biokern filed written submissions. No hearing was requested, however both parties filed submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers filed.

5. In these proceedings Biokern is represented Kunze Rechtsanwälte - Solicitor (England & Wales) PartG mbB, and KP is represented by Stobbs.

⁴ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

DECISION

Legislation and Case Law

6. The relevant provisions of section 46 of the Act state:

“(1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) [...]; (c) [...]; (d) [...].

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

7. As both contested marks are comparable marks, KP can rely upon use of those marks in the EU for any and all parts of the relevant periods which fall prior to IP Completion Day (i.e. prior to 31 December 2020). This is pursuant to paragraph 8 of Part 1, Schedule 2A of the Act (for the 769 Mark) and paragraph 8 of Part 1, Schedule 2B of the Act (for the 447 Mark). In this case, this means that use in the EU (whether inside or outside of the UK) is relevant for the entirety of the relevant periods.⁵

8. Section 100 is also relevant, it states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

9. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*⁶ as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU [Court of Justice of the European Union] in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-

⁵ Also see Tribunal Practice Notice 2/2020, paragraph 4.

⁶ [2023] EWCA Civ 1247.

259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

“106. [...] the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional

items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. [...] The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. *Case T-78/19 Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. ...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

10. In *Awareness Ltd*, the Appointed Person goes on to say that:

“28. [...] Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered [...].”

11. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.⁷ He stated:

"The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). [...] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round – or lose it"."

12. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person stated that:

"22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

13. In *Walton International*,⁸ Arnold J (as he then was), after setting out the eight applicable principles when assessing genuine use (which are the same as the eight principles he subsequently set out in *easyGroup Ltd*),⁹ added the further three principles when assessing genuine use in the EU:

"118. *The law with respect to genuine use in the Union*. Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark "in the Union". In this regard,

⁷ Case BL O/424/14.

⁸ *Walton International Ltd & Anor v Verweij Fashion BV*, [2018] EWHC 1608 (Ch), (which is also a decision by Arnold LJ, or Arnold J as he then was, that predates his decision in *easyGroup Ltd*).

⁹ *Ibid.*, paragraphs 114 and 115.

the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:

(9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]–[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50].”

14. The genuine use provision is not there to assess economic success or large-scale commercial use.¹⁰ An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹¹

15. In assessing evidence of use I bear in mind the provisions of section 46(5) of the Act which allow for partial revocation. Thus in determining a fair outcome to a non-use challenge, it may be necessary to frame a fair specification where there has been genuine use in relation to some goods but not others. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law with regard to partial revocation as follows:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they

¹⁰ *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

¹¹ *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

16. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those

which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

17. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J stated that:

“where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment.”

18. Carr J also pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.¹²

Interpretation of the registered terms

19. Before I proceed with considering the evidence, I shall first interpret the terms contained in the specifications and shall bear those interpretations in mind when assessing the evidence.

20. I note that the specification for the Word Mark contains the term “*material for dental fillings and dental impressions*” whereas the specification for the Figurative Mark contains the term “*material for stopping teeth, dental wax*”, however, these terms are broadly equivalent to each other. Furthermore, I note that the specification for the Word Mark contains the term “*pesticides*”, whereas the specification for the Figurative Mark contains the term “*preparations for destroying vermin*”, however, for reasons that will become apparent, these terms are broadly equivalent to each other. The

¹² Carr J gives this example at [47(v)].

remainder of the terms making up both specifications are identical to each other.¹³ I have set out my interpretations below:

(1) Pharmaceutical and veterinary preparations

These relate to medicinal drugs for human beings and for animals.

(2) Sanitary preparations for medical purposes

(a) The term ‘sanitizing’ means to lower (to a safe level) the number of germs and bacteria found on surfaces to minimize risks to health from disease and infection – which involves cleaning the surfaces to remove dirt and debris and then disinfecting them (typically with chemicals) to kill the germs and bacteria.

(b) I therefore interpret the term ‘sanitary preparations for medical purposes’ as substances used to sanitize medical work surfaces and implements and even skin/wounds.

(3) Dietetic substances adapted for medical use, food for babies

(a) There are two separate products included here – the one is self-explanatory, and that is “*food for babies*”.

(b) The other term is “*dietetic substances*” which are “*adapted for medical use*”.

(c) According to the Collins English Dictionary, the word ‘dietetic’ means denoting or relating to diet / regulation of food intake; prepared for special dietary requirements. The Oxford English Dictionary contains the following entries:

- “The branch of medicine concerned with the effects on health of the diet and its regulation; Of or relating to dietetics; (now) esp. of or relating to

¹³ The goods included in the specifications are almost the complete list of goods contained in the Class heading for Class 5 of the Nice Classification system. The Class 5 heading being: “*Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for human beings and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.*”

the regulation of the kind and quantity of food eaten, chiefly in the context of medicine and public health”; and

- “Designating food or drink prepared or suitable for those on special diets” giving the following as examples of its use – “It is with these dietetic and macrobiotic dishes that I have cured thousands and thousands of desperate patients”; and “Nutritional drink mix for use as a meal replacement;..Dietetic products for invalids.”

- (d) Both trade marks are derived from EU registrations, and I note that the EUIPO trade mark guidelines state that ‘*dietetic substances adapted for medical use*’ are substances prepared for special dietary requirements with the purpose of treating or preventing a disease (and as such, the EUIPO likens them to ‘pharmaceutical products’ insofar as the EUIPO considers both categories of products are used to improve a patient’s health).¹⁴
- (e) Taking the foregoing into account, I consider that the term “*dietetic substances adapted for medical use*” would likely encompass the type of substances that could be given on a drip feed to a patient and/or intravenously; and substances that a patient could take orally and/or eat or drink, to prevent them from becoming malnourished, perhaps because their bodies are incapable of digesting/processing specific nutrients; they could also potentially cure them from a medical condition relating to insufficient nutrients in their diet; or they could, on the other end of the scale, be substances which help to control obesity to improve a person’s health. Thus they are ‘*adapted*’ in some way (perhaps with special formulations) to treat a specific medical condition. These substances could potentially provide the sole source of nourishment for a patient or they could supplement/ complement a patient’s food intake. Given that they are for ‘*medical use*’ they are likely to be provided/ prescribed under medical supervision.

¹⁴ See the EUIPO’s published Trade Mark Guidelines, Part C, Section 2, Chapter 2, Part 5.1.3.

(4) Plasters, materials for dressings

The term 'plasters' refers to a specific form of small, adhesive dressings used to cover a superficial wound such as a cut or a graze. Whilst 'plasters' are dressings, not all dressings are plasters. Therefore the term 'materials for dressings' encompasses plasters as well as other clean or sterile materials used to cover a wound, such as bandages.

(5) Material for stopping teeth, dental wax" and "material for dental fillings and dental impressions"

"Material for stopping teeth" is essentially *"material for dental fillings"* both being special composites for filling cavities in teeth; and *"dental wax"* is essentially a specially formulated wax (material) which can be used for taking *"dental impressions"*.

(6) Disinfectants

A disinfectant is an agent used for killing harmful germs such as bacteria and viruses.

(7) Preparations for destroying vermin

The term vermin is extremely broad and encompasses both nuisance animals and insects which are considered to be harmful to human health, crops, livestock or property, this is because they can spread diseases, contaminate food and destroy crops and property. Some typical examples include rodents such as rats and mice; lice; fleas; cockroaches; and mosquitoes. preparations for destroying vermin would therefore encompass insecticides or pesticides and would also extend to a specific sub-category of the same, being repellents.

(8) Pesticides

A pesticide is a preparation used to prevent (deter) and kill 'pests', particularly insects and rodents.

(9) Fungicides, herbicides

Fungicides are preparations used to prevent and kill parasitic fungi from growing on plants. Herbicides are substances used to kill or inhibit the growth of unwanted plants for example, weedkillers.

Evidence

21. KP filed its evidence in the form of the witness statement of Carlos Berrade, a Business Development Director at Kern Pharma, S.L., dated 28 June 2024, accompanied by exhibits CB1-CB17.

22. The use period for the Figurative Mark is the earlier use period and, as previously stated, that period is 29 January 2009 to 28 January 2014. The use period for the Word Mark is 19 February 2013 to 18 February 2018. Although the two periods slightly overlap, they are largely separate to one another. KP has adduced evidence which covers the span of those two periods from 2009 to 2018 as well as some evidence which is dated after 2018. When reviewing the evidence, I bear in mind the potential for the registrations to benefit from the provisions of section 46(3) of the Act, this is because if there is a commencement/resumption of use 3 months or more prior to the application for revocation being filed, that is sufficient to avoid KP's marks being revoked.

23. I note that Exhibits CB2 and CB8 contain text in Spanish. KP has confirmed with the Registry that this evidence has been provided in order to show use of the trade marks in relation to the relevant goods and that any Spanish wording is ancillary and not required to be translated.¹⁵ With regard to Exhibit CB14 which contains invoices in Spanish, KP provided an English translation template to indicate the relevant translations of wording common to all the invoices.¹⁶

¹⁵ See the Registry's official correspondence dated 3 July 2024 and KP's response thereto dated 16 July 2024.evidence

¹⁶ See the Registry's official correspondence dated 3 July 2024 and KP's response thereto dated 16 July 2024. The translation template is included at page 221 of Exhibit CB14.

Background

24. According to Mr Berrade, KP has become a well-known company in the pharmaceutical space since its inception in 1999, and he states that KP is specifically known for its *“development, manufacturing and marketing of generic medicinal products – whereby they develop and manufacture their own products but are also focused on the manufacturing of products for third parties.”*

25. Mr Berrade divides his evidence in relation to KP’s products under four headings. I have used the same headings (underlined below and numbered (1) to (4)) for ease of reference.

(1) Medicines / pharmaceutical preparations

26. I note that the registered term for which use must be proven is *“pharmaceutical and veterinary preparations”*.

27. Under the above heading, Mr Berrade’s narrative evidence states that this category of KP’s products consists of: (a) generic medicines (i.e. genericised medications, with generic formulations as opposed to proprietary formulations and that they are typically *“referred to by their generic name (e.g. paracetamol or ibuprofen)”* and are available through prescription from a doctor or medical professional. He states that such products are produced for and sold to pharmacies or medical providers who in turn dispense them to patients via a prescription; and (b) consumer medicines – being pharmaceutical drugs typically offered direct to consumers ‘over the counter’ i.e. typically without the need for a prescription.

28. Mr Berrade has produced Exhibit CB2 which includes product lists, catalogues and website evidence (the latter being obtained through the Wayback Machine) to show examples of KP’s products falling under his “Medicines / pharmaceutical preparations” heading. I note that whilst some images/ information included in this evidence is undated, the invoice evidence contained in Exhibits CB14 and CB15 (which is clearly dated within the relevant periods) shows that the pharmaceutical products displayed in those images were sold during the relevant periods.

29. Exhibit CB2 includes examples of pharmaceutical products such as paracetamol and ibuprofen as well as copious other pharmaceutical products such as: ‘finasterida’; ‘metformina’; ‘aciclovir’; and ‘cloperastina’ to name a few. Images taken from the Exhibit CB2 are included below (these images are obtained from evidence dated within the relevant periods):



30. Press releases detail KP’s expansion of its pharmaceutical range, for example, the launch of ‘fluvastatin’ (to reduce cholesterol) in 2013; ‘candesartan/hydrochlorothiazide (for hypertension) and ‘moxifloxacin’ (an anti-infective drug) in 2014; ‘pitavastatin’ (for high cholesterol) and ‘dexamethasone’ (for the treatment of

Covid-19) in 2020.¹⁷ I include some images below:



(2) Sanitary products and disinfectants, vermin repellent

31. I note that the registered terms for which use must be proven are: *“sanitary preparations for medical purposes; disinfectants; pesticides; preparations for destroying vermin.”*

32. Under this heading Mr Berrade states that this category of KP’s products: *“includes products such as [(i)] povidone iodine (a type of disinfectant), [(ii)] rosemary alcohol, [(iii)] hydrogen peroxide and [(iv)] 96° ethyl alcohol (antiseptics), [(v)] vaseline, [(vi)] aloe vera gels, [(vii)] lice [repellents] and [(viii)] bug repellents, and [(ix)] physiological serum (intended for washing of the nose, eyes, ears and general wound washing),”* (the numbering is mine for ease of reference).

33. Images of the products numbered (i) through (ix) are included in Exhibits CB1, CB2 and CB3. KP lists those products as ‘personal care’ products in its catalogues and on its website. I also note that those exhibits contain evidence of a ‘tired legs’ lotion¹⁸ under the ‘personal care’ heading as well as rosehip gel¹⁹. All of the foregoing products display the wording ‘KERN PHARMA’ in capital letters on their front-of-pack labels – I include some example images below. I note that whilst the packaging labels are in Spanish, the website evidence includes the English name for those products too. The front-of-pack labels for the aloe vera and rosehip gels indicate that they are ‘body lotions’.

¹⁷ See Exhibit CB6.

¹⁸ “Piernas cansadas” in Spanish – see CB1 page 23, CB2 page 38 and 40.

¹⁹ “Rosa mosqueta” in Spanish – see CB2 page 38 and 40, CB3 page 60

“96° ethyl alcohol”



“insect repellents”



“hydrogen peroxide”



“rosemary alcohol”



“povidone iodine”



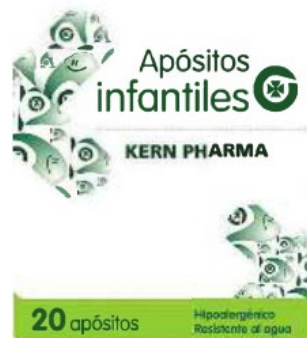
“physiological serum”



(3) Plasters / dressing materials

34. I note that the registered term for which use must be proven is “*plasters, materials for dressings*”.

35. Mr Berrade states that “*this category includes products such as plasters or dressings (including those for children)*”, and refers to Exhibit CB4 for images of a “*select range*” of such products and Exhibit CB2 where such products are listed under “*personal care*” items. This evidence is confined to two products and they are dressings in the form of ‘plasters’ only (the plasters for children are merely plasters with a patterned design as opposed to being plain). Images of the labels for those two products and the product list in which they are included is below:



K PERSONAL CARE	
C.N.	PRODUCTO
158747.3	Agua Oxigenada 250 ml Kern Pharma
158749.7	Alcohol 96° 250 ml Kern Pharma
164821.1	Alcohol De Romero 250 ml Kern Pharma
164823.5	Alcohol 70° 250 ml Kern Pharma
162478.9	Apósitos Adultos
162477.2	Apósitos Infantiles
164468.8	Expositor 10 Gel Aloe Vera
164469.5	Expositor 10 Gel Rosa Mosqueta
164470.1	Expositor 10 Gel Piernas Cansadas
160985.4	Gel Loción Rosa Mosqueta
160984.7	Gel Loción Aloe Vera
160987.8	Gel Loción Piernas Cansadas
165675.9	Kit Viaje
158748.0	Povidona Iodada 50 ml Kern Pharma
161320.2	Repelente de Insectos Kern Pharma 100 ml
162114.6	Repelente de Piojos Kern Pharma 100 ml
168878.1	Suero Fisiológico 18
166277.4	Suero Fisiológico 30
160453.8	Vaselina Kern Pharma Tubo de 60 g

(4) Dietetic substances

36. I note that the registered terms for which use must be proven are as follows (the dietetic substances are subject to a limitation – shown in emboldened font): “*dietetic substances adapted for medical use, food for babies*”.

37. For ease of reference, I transcribe the entirety of Mr Berrade’s narrative evidence under this product heading:

“This category includes vitamin supplements such as vitamin D and omega 3 acid. Enclosed at Exhibit CB5 is a historic Wayback Machine screenshot showing Kern Pharma's Vitamin D product, and the "Personal Care" product list (of 2015) at Exhibit CB2 shows the Omega 3 Acid product.

In addition to the above dietetic products, Kern Pharma has since 2017 been selling a range of health nutrition products under the sub-brand Finisher - such as multivitamins and minerals, mineral salts, energy and protein bars, thermogenetic capsules (to regulate metabolism), creatine, whey protein, collagen and others. Enclosed at Exhibit CB5 is a press release detailing the launch of Kern Pharma's Finisher sub-brand and associated products, as well

as a selection of historic Wayback Machine screenshots of my company's Finisher website showing the abovementioned range of dietary products.”

38. Images of the ‘omega 3 acid’ and the ‘vitamin D’ products included in the aforementioned exhibits show the following signs on the packaging:

Kern Pharma



39. The product packaging for the ‘Finisher’ line of products include the sign below on the left, which is displayed below the ‘Finisher’ logo as shown below on the right:



40. The press release announcing the launch of the Finisher line of products in 2017 states:²⁰

“Kern Pharma launches Finisher, its new health and sports nutrition line. Sold in pharmacies, the range includes three products specially developed for before [physical activity i.e. ‘Finisher Intensity’], during [physical activity i.e. ‘Finisher Endurance’] and after physical activity [i.e. ‘Finisher Recovery’], a multivitamin with minerals [i.e. ‘Finisher multivitamin with minerals’], a product for performance and recovery [after physical activity i.e. ‘Finisher FuturPro’] and another specific for joint health [which stimulates tissue regeneration, improving joint mobility and contributing to the maintenance of bones in normal conditions i.e. ‘Finisher CondroStop’].

[It is] a range that is intended for the end consumer and that aspires to become a philosophy for life. Finisher is aimed at those athletes who want to have nutritional supplements to improve their performance and those people who

²⁰ Exhibit CB5, pages 63 and 64.

want to maintain a healthy lifestyle, whatever their physical activity or profession. [...]

[The] CEO of Kern Pharma [states that], “[...] With this line of sports nutrition we want to take care of the health of people who play sports, a group that is growing and for which the pharmacist can be a key figure of advice and support.””

41. By 2020, the evidence shows that the Finisher line of products extended to vegan protein powder and a caffeine gel, and in 2021 it extended to energy bars and ‘Finisher Thermogenic’ (being a weight control supplement) for example. These products include notices and/or disclaimers on KP’s website such as:²¹

- “Finisher Vegan Protein is a food product for athletes, adapted to intense muscle wasting”
- “Finisher Caffeine Gel” and “Finisher Thermogenic” are “food supplement[s] and should not be used as a substitute for a varied and balanced diet and healthy lifestyle”
- “[Finisher Energy Bars are] bars to take before physical activity or between meals, ideal for recovering normal muscle function”.

Sales Data

42. Mr Berrade provides an inordinate selection of raw sales data for the EU (inclusive of the UK) by way of Exhibit CB17, dated within the relevant periods.²² These raw data sets show sales data *“split by product name, year of sale and country of sale”* according to Mr Berrade’s narrative evidence. Mr Berrade states that the product names listed in these data sets *“can be linked to the KERN PHARMA-branded products referenced in Exhibit CB2”*.²³ The data sets contain an excessive amount of information that require interpretation and it would be disproportionate for me to summarise this raw data into a readily comprehensible format. However, what I will

²¹ See Exhibit CB5, pages 65 to 67.

²² I do not use the term ‘inordinate’ lightly because there are 155 pages of data compressed onto 53 pages of evidence.

²³ See paragraph 24 of Mr Berrade’s Witness Statement.

note is that I can see that the raw data displayed in Exhibit CB17 includes a vast selection of the pharmaceutical products listed in the catalogues contained in Exhibit CB2, including, for example, paracetamol, ibuprofen, finsaterida, candesartan, metformin etc.; as well as other products, for example, omega 3 acid, vitamin D, products in the 'Finisher' range, aloe vera gel and rosemary alcohol.

43. Whilst Mr Berrade has transposed some of the raw sales data into various tables under paragraph 25 of his witness statement, the tables he has prepared only relate to the total annual sales of "*KERN PHARMA-branded products*" (not broken down by product) and the sale of "*sanitary, hygienic and disinfectant related goods*". The data in the tables covers the two relevant periods.

44. The first two tables included in paragraph 25 of Mr Berrade's witness statement show that the total annual sales of "*KERN PHARMA-branded products*" from 29 January 2009 to 28 January 2014 are in excess of €590 million Euros; and for the period covering 19 February 2013 to 18 February 2018 they are in excess of €946 million Euros.²⁴ Whilst this data is not broken down by product, it nonetheless is derived from the raw data included in Exhibit CB17, which is broken down by product – which includes the products shown in the catalogues and website evidence.

45. Pages 247 and 270 of Exhibit CB17 (from which the data for the total annual sales of "*KERN PHARMA-branded products*" derives), show that the lion share of the sales relate to Spain. The other territories to which the total sales relate are Portugal (which is in second place by sales volume), Austria, Belgium, Cyprus, Czech Republic, Germany, France, Great Britain, Greece, Hungary, Ireland, Lithuania, Luxembourg, Netherlands and Sweden.

46. Mr Berrade divides the remainder of his tables at paragraph 25 of his witness statement into four groups, namely (i) 'sanitary alcohols'; (ii) 'povidone iodine/disinfectants'; (iii) 'plasters/ dressings'; and (iv) 'sanitary gels (aloe vera, rosa mosqueta etc.)'. He states that these tables show a spread of sales across "*sanitary, hygienic and disinfectant related goods (i.e. those detailed at Exhibits CB3 and CB4)*" from 29 January 2009 to 28 January 2014 and from 19 February 2013 to 18 February

²⁴ This data is contained in pages 247 and 270 of Exhibit CB17 and in the first two tables shown in paragraph 25 of Mr Berrade's witness statement.

2018. I note that there is no data from 2009 and 2010 for any of the four categories and additionally no data for 'plasters / dressings' in 2011 either. The total sales shown for the four groups of goods identified by Mr Berrade (underlined below) are as follows:

- The sale of 'sanitary alcohols' totalled in excess of €250 thousand Euros in the first period and in excess of €760 thousand Euros in the second period.
- The sale of 'povidone iodine/disinfectants' totalled in excess of €250 thousand Euros in the first period and in excess of €650 thousand Euros in the second period.
- The sale of 'plasters/ dressings' totalled in excess of €5 thousand Euros in the first period and in excess of €14 thousand Euros in the second period.
- The sale of 'sanitary gels (aloe vera, rosa mosqueta etc.)' totalled in excess of €230 thousand Euros in the first period and in excess of €285 thousand Euros in the second period.

47. Exhibits CB14 and CB15 contains an inordinate selection of invoices dated from 2009 to 2018 and headed with the below sign.²⁵



48. The invoices primarily show sales of a vast array of pharmaceutical/ medicinal products such as 'paracetamol', 'ibuprofen', 'metformin' (an antidiabetic drug),²⁶ 'dexamethasone' (an anti-inflammatory drug),²⁷ etc. – essentially the pharmaceutical products listed in KP's product lists and catalogues contained in Exhibit CB2 as well as its archived website pages in Exhibit CB3. The delivery addresses are for the most part based in Spain, however, some are based in other parts of the EU including the UK. According to Mr Berrade's narrative evidence, these invoices were issued to medical or pharmaceutical suppliers.

²⁵ Again, I do not use the term 'inordinate' lightly. Exhibit CB14 alone has 4 pages per one page of evidence, meaning that it contains 359 pages of evidence which have been spread across 89 paginated pages of evidence.

²⁶ See description of 'metformin' / 'metformina' included in Exhibit CB2, page 55.

²⁷ An image of this product is included on page 53 of Exhibit CB2.

Business growth and investment

49. Mr Berrade provides press releases which detail business growth and investment. They are as follows:²⁸

Business Growth

- A 2015 press release states that in *“2014, Kern Pharma’s turnover amounted to 172 million euros. 77% corresponds to the national [Spanish] market and 23% to international sales. These sales have been possible thanks to the launches – 31 new products and 54 new presentations, – the diversification of the business and the taking advantage of market opportunities”*.
- A 2016 press release states that Kern Pharma’s 2015 sales rose 21% from 2014 (to 206.9 million Euros) and that whilst 77% of its business was concentrated in its national market (Spain), it continued with its objective to increase sales abroad, which grew by 18%. The press release also states that Kern Pharma *“continues to be one of the leading generic medicines companies in Spain. This line represents 63% of its turnover and is key to its activity”*.
- A 2019 press release reports that in 2018, Kern Pharma had a turnover of 280 million euros, representing a 17% increase compared to the previous year – 76% of that turnover corresponded to Spain and 24% to foreign markets – and that generic medicines continued to be the company’s core business.

Investment

- A 2015 press release announces Kern Pharma’s investment in its facilities. In particular it states:

“Kern Pharma, the company dedicated to the development, manufacturing and marketing of pharmaceutical products [...] has just invested 11.5 million Euros in expanding its logistics centre [including doubling] its warehouse capacity [...].

²⁸ See Exhibit CB6 for the press releases.

The laboratory has also invested 2.2 million euros during 2014 in its production plant [...].

This continued investment in its facilities – more than 71 million euros since its creation in 1999 – has enabled the laboratory to break two of its records in 2014. It produced 108 million units and distributed 60.5 million. These figures place the company's facilities among the most important in the sector, they occupy 59,000 m² and include laboratories, a drug production plant, a chemical plant, a logistics centre and offices. Specifically, Kern Pharma occupies third place in the ranking of generic drug factories in Spain by volume of units.”

Promotional activities

50. Mr Berrade provides various examples of KP's promotional activities, I have detailed some of them below:

- (1) Promotion of 'Kern Pharma' via social media platforms, being 'X' (formerly 'Twitter'), 'Facebook', 'Linkedin' and 'Instagram'.

A post on the Kern Pharma page on Facebook from 2016 asks *“Do you know Kern Pharma's Personal Care range? The lineup of essentials for a complete first aid kit”*, and it includes the below image showing the following of KP's products – ethyl alcohol, hydrogen peroxide, insect repellent, aloe vera gel, rosehip gel, tired legs lotion, lice repellent, vaseline, povidone iodine and both types of plasters (normal and children's).



(2) Sponsorship and promotion at sporting events

For example, at a basketball event in Spain in 2018 (see image below on left)²⁹ and a golfing event in 2019 (although the golfing event was sponsored by ‘Finisher’ – see image below on right);³⁰ and sponsorship of a Spanish cycling team known as the “Kern Pharma Team” – a professional cycling team who made their debut in competition in 2020, and is currently still sponsored by Kern Pharma.³¹



(3) Attendance at conferences

For example a world event held in Frankfurt for the chemical and pharmaceutical industry in 2019;³² and ‘Infarma’ (a European pharmaceutical and medicine conference and exhibition held yearly in Spain. According to the Infarma website, it is a conference dedicated to pharmacies and provides a way for suppliers to create awareness of their products to pharmacists; and the website states that 30,000 of its attendees are professionals in the pharmaceutical sector and that 10,000 of its attendees are registered pharmacists.³³

²⁹ See the Kern Pharma post on Facebook, 24 November 2018, Exhibit CB8, page 97

³⁰ Exhibit CB8 at page 100.

³¹ The “Kern Pharma” cycling team have their own dedicated social media pages across various platforms and posts include images of cyclists wearing jerseys with ‘Kern Pharma’ sponsorship. See Exhibit CB11.

³² Exhibit CB8 at page 100.

³³ Exhibit CB12.

KP attended the Infarma conference as exhibitors in 2015, 2017 and 2019. An image of its 2017 booth is below. A press release announcing it would present at the 2015 conference states that KP would be “*presenting the latest developments from its Kern Pharma Consumer division for self-care [and that it would be announcing] the most recent launches of this division under which it markets over-the-counter medicines, non-financed prescription medicines and personal care products.*”³⁴ The press release gives examples of the products that would have been presented (see extract below) – in particular I note that the ‘aloe vera’, ‘rosehip’ and ‘tired legs’ gels are all described as ‘cosmetic gels’ and that ‘vaseline’ is described as an ‘emollient’:

For example, among over-the-counter medications, Dolostop and Dolostop Pediátrico (paracetamol), Dormikern (doxylamine), Viskern (carmellose sodium) or KernGrip Forte, among others, stand out. In the range of non-funded prescription drugs, Ibukern (ibuprofen) and, in personal care, aloe vera, rosehip and tired legs cosmetic gels, physiological serum in single-dose format, disinfectants and antiseptics, emollients such as Vaseline and repellents of insects and lice.



(4) Television advertising

Mr Berrade provides one example of a television advertisement for KP’s ibuprofen-based product which it sells under the brand ‘Ibudol’. The television campaign was launched in 2016 and aired in Spain, to promote the new ‘stick pack’,³⁵ I also note that the advertisement was published online in 2016 on the ‘YouTube’ platform and, at the time the evidence was gathered, it had received in excess of 42 thousand views. An undated image

³⁴ Exhibit CB6, page 71.

³⁵ Exhibit CB6, page 72.

of the 'Ibudol' stick pack product is below on the left,³⁶ and a still from the 2016 advertisement is below on the right:³⁷



51. Mr Berrade provides the following table in Exhibit CB13, which he states is “a breakdown of total company expenditure (in Euros) for the years 2009 - 2018, whereby “Marketing Promotion” is listed as the promotional spend. Also listed on separate lines are spending figures related to promotion via attendance of trade fairs/ exhibitions and congresses (such as Infarma), as well as donations and volunteering projects”:

Totals Account	Desc. Cuenta	Year										Total general
		(01-2009-12-2009)	(01-2010-12-2010)	(01-2011-12-2011)	(01-2012-12-2012)	(01-2013-12-2013)	(01-2014-12-2014)	(01-2015-12-2015)	(01-2016-12-2016)	(01-2017-12-2017)	(01-2018-12-2018)	
627000	Stands/Halls Fairs/Congresses	15,000	15,000	15,000	16,721	30,544	39,523	41,950	57,559	48,616	50,949	330,864
627001	Publicity and propaganda	428,354	493,739	437,637	584,349	733,252	541,547	687,108	1,461,872	769,578	1,637,617	7,775,054
627002	Gadgets	246,654	205,763	272,523	241,978	534,871	230,363	320,741	360,304	351,719	377,013	3,161,949
627004	Expenses. Communication agency	28,925	36,000	40,000	29,998	43,475	39,960	81,247	76,210	236,269	450,530	1,062,614
627512	Finished Product Samples						14,914	36,276	26,242	50,958	104,023	244,750
627821	Marketing Promotion Gtos.	1,560,416	1,603,027	2,295,193	2,166,056	2,931,668	2,978,586	4,282,527	3,104,692	3,782,321	4,003,387	28,707,872
627822	Export Promotion Costs							12,097	82,849	59,138	23,193	177,276
627823	Network Promotion Gtos.							0	434,076	920,577	951,103	2,305,757
627900	Donations	0	42,005	71,212	167,140	181,171	224,805	292,905	331,525	606,147	902,425	2,819,336
627901	Medication Donation							0	18,151	63,932	51,116	133,199
627902	Social Action Donation							0	156,230	152,285	81,413	389,927
627903	Social Action: Projects							0	14,804	5,074	17,017	36,895
627904	Social Action: Volunteering							0	6,372	2,335	508	9,205
627905	Corporate social responsibility: Others							0	9,700	6,220	13,000	28,920
Total general		2,279,348	2,395,554	3,131,566	3,206,243	4,467,319	4,069,698	5,754,851	6,160,586	7,055,160	8,663,294	47,183,618

52. Excluding the expenditure on donations and social projects, I note that KP’s expenditure was in excess of €43 million Euros from 2009 to 2018, included in this sum is the “marketing promotion” expenditure which was in excess of €28 million Euros from 2009 to 2018.

³⁶ Exhibit CB2, page 56.

³⁷ Exhibit CB10.

Form of the mark

53. For the purpose of section 46(1) of the Act, use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes,³⁸ (I note that Schedules 2A and 2B of the Act state that references in section 46 to the United Kingdom include the European Union).³⁹

54. Put plainly, if the form in which a mark is used alters the distinctive character of the mark, then that form is not a ‘variant form’ and use of such sign cannot be relied on to establish genuine use of the registered trade mark.

55. Biokern contends that KP’s evidence “*does not show genuine use of the marks as registered.*”⁴⁰ In addition, it submits that the statutory provision on ‘variant form’ does “*not give the right to extend, by proof of use, the protection enjoyed by a registered trade mark to another registered trade mark, the use of which has not been proved, on the ground that the latter is merely a slight variation of the former.*”⁴¹ In this regard it submits that:⁴²

“13. [...]”

[The figurative trade mark] is registered in a particular form and arranged in a particular manner:



when use is being shown in the documents furnished by the registrant, such use, if any, is limited to the following form:



³⁸ Section 46(2) of the Act.

³⁹ In particular paragraphs 8(2)(b) of Part 1 of the respective schedules.

⁴⁰ Biokern’s submissions in lieu, dated 17 October 2024, paragraph 15.

⁴¹ Biokern’s submissions in lieu, dated 17 October 2024, paragraph 12.

⁴² See Biokern’s submissions in lieu.

14. This form, however, cannot constitute as use within the scope of protection assigned to the trade mark as registered. The different positioning of the device element 'K' cannot be said to be negligible, since the position of that element in the mark as registered is characterised by its position at the top above 'Kern Pharma' and, therefore, the change in position in a horizontal position in line with the other element 'Kern Pharma' gives the addressed trade circles a very different impression from that produced by the earlier mark in its registered form. This applies all the more as the mark in its registered form is a coloured device mark and any change in that respect must therefore be regarded as material.

[...]

24. [...] the documents furnished by the proprietor are not apt to show use of the trade marks, neither as registered nor as referred to above, namely:



and

KERN PHARMA®,

for the goods for which they are registered. Where the signs are displayed, can only, if at all, be perceived as a trade name as opposed to a trademark.”

56. Biokern’s submissions on variant form are narrowly framed and fail to take into account the fundamental purpose of that legislative provision, neither do its submissions take into account the accepted case law principles when assessing use of a mark in a variant form.

57. The purpose of the statutory provision on ‘variant form’ is to avoid imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, and therefore to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. Where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the aforementioned provision envisages that the

obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade.⁴³

58. Thus, the correct approach in assessing whether a mark has been used in a 'variant form' requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences).⁴⁴

59. In *Colloseum Holdings AG v Levi Strauss & Co.*,⁴⁵ the CJEU stated (my emphasis for clarity):

“[...] as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, [Case C-353/03], the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.”⁴⁶

60. The mark for which genuine use must be shown “*need not necessarily have been used independently [...] it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark [...], as originating from a given undertaking.*”⁴⁷ In other words, “*a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must [nevertheless] continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’.*”⁴⁸

⁴³ See the General Court ruling in T-194/03 *Il Ponte Finanziaria* [2006] ECR II-445 at paragraph 50 (not overturned by the Court of Justice C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7333).

⁴⁴ See *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, paragraph 13.

⁴⁵ Case C-12/12

⁴⁶ *Ibid.*, paragraph 32. It is noted that in the ‘*Nestlé*’ case (referenced by the CJEU), the court was asked to express a view on the rules concerning the distinctive character of trade marks. In *Nestlé* the dispute turned on whether the advertising slogan ‘*HAVE A BREAK*’ was able to acquire distinctive character as a result of its use as a part of the registered trade mark ‘*HAVE A BREAK ... HAVE A KIT KAT*’. The nub of the legal dispute was the question whether this kind of use of a sign can result in distinctiveness for trade mark purposes or whether it precludes recognition as a trade mark.

⁴⁷ See *Nestlé*, Case C-353/03, paragraphs 27 to 30 – which are the paragraphs the CJEU makes reference to in *Colloseum* (Case C-12/12). Although *Nestlé* addresses ‘use’ through which a trade mark acquires distinctive character, as the CJEU pointed out in *Colloseum*, at paragraphs 33 – 34, the criterion of use is still the same i.e. the requirements that apply to verification of the genuine use of a mark, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration.

⁴⁸ *Colloseum*, Case C-12/12, paragraph 35.

61. In *Lactalis McLelland Limited v Arla Foods AMBA*,⁴⁹ Professor Phillip Johnson, sitting as the Appointed Person, in considering the correct approach to the ‘variant form’ test, stated (my emphasis):

“15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, **where a mark contains words and a figurative element the word element will usually be more distinctive**: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. **This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.**









16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, **the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark**: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 *CAPTAIN* (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).”

62. Clearly, where the marks have been used exactly as registered, KP will be able to rely upon this to demonstrate use of the marks. However, where the marks have been used in combination with additional matter or in a variant form, it is necessary to assess whether this is acceptable use of the marks as registered or an acceptable variant of the marks.

63. The body of evidence demonstrates that KP affixes the following signs to its product packaging (sometimes two or more of the below signs are used in combination

⁴⁹ BL O/265/22

with each other, as is demonstrated by the ibuprofen packaging for example – as shown in my paragraph 68 – which uses signs (2), (4)(a) and (6)(a) listed in the below table), and that KP uses one or more of those signs in its marketing and promotional materials and on the invoices it submits to its customers:

(1)	KERN PHARMA		
(2)	Kern Pharma		
(3)	(a) 	(b) 	
(4)	(a) 	(b) 	(c) 
(5)			
(6)	(a) 	(b) 	

64. Firstly, addressing the Word Mark, I note that the evidence shows use of ‘KERN PHARMA’ and ‘Kern Pharma’ on product packaging, this is clearly use upon which KP can rely.

65. The mark for which genuine use must be shown “*need not necessarily have been used independently*”. Therefore I also find that KP has used its Word Mark not only on its own, but also as part of the composite marks shown in rows (3), (4) and (5) of the above table, and that this is also use of the registered word mark upon which KP can rely, this is because the mark continues to indicate origin notwithstanding it is used alongside a figurative device. In making this finding I have taken into account that whilst ‘KERN’ is larger and placed above ‘PHARMA’ in signs (3)(a) and (b), (4)(a), (b) and (c), this placement does not alter the distinctive character of the words themselves

and the mark continues to indicate origin (when bearing in mind that registered word marks protect the words themselves, not any particular presentation of the words).⁵⁰

66. Now moving on to the Figurative Mark. I bear in mind that when comparing the alterations between the mark as registered and used, it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole; and that where a mark contains words and a figurative element, the word element will usually be more distinctive, which suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.⁵¹

67. The distinctive character of the registered mark rests in the words 'KERN PHARMA' and the 'K' device. The stylisation of the wording in signs (3)(a) and (b) and (4)(a), (b) and (c), remains unchanged from the stylisation presented in the registered mark. Signs 3(a) and (4)(a) and (b) are presented in different colours to those of the registered sign. However, the different colour is not an element which changes the distinctive character of the registered mark and represents a variation to the registered mark which is acceptable within the parameters of 'variant form'. The stylisation of the 'K' device itself remains unaltered from its registered form, it is only its placement which is altered, as it appears either to the left or to the right of the wording (as opposed to above it). However, the altered placement of this figurative element is a minor difference which does not change the distinctive character of the registered mark. Therefore signs (3)(a) and (b) and (4)(a), (b) and (c) are acceptable variants of the registered mark and use of those signs is use upon which the opponent may rely.

68. I note that there is use of the 'K' device on its own in the evidence (as shown in row (6) of the table and in the product image below). However, given the consistent use of KP's registered marks (or at least an acceptable variant of the same) on product packaging, I do not need to consider whether use of the 'K' device solus is use upon which KP can rely.

⁵⁰ See the comments of Iain Purvis KC, sitting as the Appointed Person in the following two cases: *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14, paragraph 21; and *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraph 37.

⁵¹ *Lactalis*.



Conclusions on the evidence

69. Although the use presented is predominantly in relation to Spain, the use evidence relating to Spain is significantly quantitative, furthermore, the evidence shows sales of products to other EU territories, therefore I am satisfied that the evidence relates to the relevant territory.⁵²

70. The evidence of use spans the two (slightly overlapping) relevant periods. Whilst there has been use presented of the Figurative Mark beyond the relevant period for which use must be shown (including during the relevant five year period relating to the Word Mark), I am able to take that evidence into account pursuant to section 46(3) of the Act. The same can be said for use of the Word Mark which goes beyond the relevant period which applies to it. I also bear in mind my finding that use of the Figurative Mark (or an acceptable variant thereof) is considered to be use of the Word Mark, albeit as part of a composite mark.⁵³

71. Despite the invoices all being headed with the following sign:



Biokern has criticised the fact that the invoice evidence does not list the brands of the pharmaceutical products, and therefore should not be considered as being sold under the contested marks. I find that this submission is misguided and fails to take into account the evidential picture as a whole. The evidence informs me that KP manufactures generic pharmaceutical products and sells them to medical or pharmaceutical suppliers – the products listed in the invoices are therefore the generic

⁵² *Walton International*, paragraph 118.

⁵³ *Colloseum Holdings*.

names of those medicines and would not be sold under a proprietary name/brand by the mere fact that they are generic. The images of the generic products show that they display, for the most part, the wording 'KERN PHARMA' and/or an acceptable variant of the Figurative Mark. There is therefore no question that the generic medicines listed in the invoices were sold under the contested marks.

72. My overall assessment of the evidence is that it shows genuine use of the contested marks in the relevant territory, during the relevant periods and beyond.

73. In light of the evidence presented, I find that KP has demonstrated that it made genuine use of the marks in relation to a vast array of pharmaceuticals. Consequently, I consider that it can retain the term "*pharmaceutical preparations*" at large.

74. There is nothing in the evidence which suggests that it sells "*veterinary preparations*", or indeed any products intended for animals, therefore genuine use has not been demonstrated for that term.

75. Whilst KP has adduced evidence of use in relation to products such as 'vaseline', and body lotion gels (which are referred to as an emollient and 'cosmetic gels' respectively within the evidence), these are not sanitary preparations within the meaning of the term. However, KP has shown genuine use of more than one type of sanitary preparation used for medical purposes, i.e. its use in relation to ethyl alcohol, hydrogen peroxide, rosemary alcohol, povidone iodine and physiological serum. I consider it can therefore retain the term "*sanitary preparations for medical purposes*".

76. The only genuine use shown in relation to "*disinfectants*" is the aforementioned use in relation to "*sanitary preparations for medical purposes*", which is a sub-category of that broad term. I consider this use to also be sufficient to retain the broad term "disinfectants", because those products are not in essence different from "disinfectants" within the meaning of Class 5,⁵⁴ and cannot be distinguished from them other than in an arbitrary way. KP can therefore retain the term "*disinfectants*."

⁵⁴ When bearing in mind that goods falling under the term "disinfectants" in Class 5 include products such as alcohol-based hand sanitizer gels, disinfectant washes (essentially physiological serums) as well as disinfectant swabs – swabs can be impregnated with disinfectants such as alcohol and iodine for example.

77. The 'Finisher' product packaging shows that it displays an acceptable variant of the contested marks, therefore they continue to indicate trade origin notwithstanding they are being used in conjunction with another sign.⁵⁵ This product range relates to fitness and endurance supplements; food supplements for sportsmen; and dietary supplements for promoting fitness and endurance. In addition, there is evidence of sales of vitamin supplements being vitamin D and omega 3 acid. Whilst the foregoing are dietary supplements and dietetic substances, the registration does not cover those terms at large because it is subject to the limitation "*adapted for medical use*" – the registered term is therefore a sub-category of the broad term "*dietetic substances*". There is nothing in the evidence which suggests that the 'Finisher' products nor vitamin supplements are in any way adapted for medical use and/or used under the supervision of a medical professional and, in light of my interpretation of the registered term, I do not consider the use shown is use in relation to "*dietetic substances adapted for medical use*", therefore KP will not be able to retain that term.

78. There is no evidence of use in relation to "*food for babies*", therefore KP will not be able to retain that term.

79. There is evidence of genuine use in relation to "*plasters*", therefore KP will plainly be able to retain that term. However, whilst plasters are a sub-category of "*materials for dressings*", I do not consider KP should be able to retain the broader term, since the evidence (spanning nearly a ten year period) does not show use in relation to any form of dressing other than plasters.

80. There is no evidence of use in relation to "*material for stopping teeth, dental wax*" and "*material for dental fillings and dental impressions*", therefore KP will not be able to retain those terms.

81. There is evidence of genuine use in relation to insect repellents and lice repellents solely for use on humans. Whilst these are sub-categories of the broad terms "*preparations for destroying vermin*" and "*pesticides*", I do not consider KP should be able to retain these broader terms, which would encompass preparations such as poisons (e.g. rat poison), and substances used in agriculture and horticulture to spray crops/ plants. An appropriate fair specification would therefore be "*insect repellents*

⁵⁵ *Colloseum Holdings*.

and lice repellents all being for use on humans” – I consider this to be the appropriate term which the average consumer would use to describe the use shown.

82. There is no evidence of use in relation to “*fungicides, herbicides*”. Whilst I am aware that anti-fungal preparations exist for human use, KP has not pointed me to any medications that it sells which are for this purpose and without a translation of the Spanish catalogues, I cannot make this determination myself either. KP will not be able to retain the terms “*fungicides, herbicides*”.

83. Taking all of my findings into account, I consider a fair specification for both registrations to be:

Class 5 Pharmaceutical preparations; sanitary preparations for medical purposes; disinfectants; plasters; insect repellents and lice repellents all being for use on humans.

OUTCOME

84. The applications to revoke UK trade mark registration numbers 902943769 and 801059447 are partially successful.

85. Subject to any successful appeal, with effect from 29 January 2014, the specification for UK trade mark number 902943769 will appear as follows:

Class 5 Pharmaceutical preparations; sanitary preparations for medical purposes; disinfectants; plasters; insect repellents and lice repellents all being for use on humans.

86. Subject to any successful appeal, with effect from 19 February 2018, the specification for UK trade mark number 801059447 will appear as follows:

Class 5 Pharmaceutical preparations; sanitary preparations for medical purposes; disinfectants; plasters; insect repellents and lice repellents all being for use on humans.

COSTS

87. The Proprietor has been partially successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice (“TPN”) 1/2023.

88. In awarding costs, I have borne in mind that even though KP filed exactly 300 pages of evidence in chief, the quantity of the evidence it produced far exceeded 300 pages,⁵⁶ (and KP did not seek directions from the Registry in relation to filing excess evidence). This is clearly not in line with TPN 1/2015 and I am not going to award costs to reflect the excess evidence filed. In the circumstances, I award costs to KP as follows, bearing in mind that the success was only partial as well as taking into account the economies of consolidation:

Considering the notice of revocation and preparing a counterstatement x2	£500
Preparing evidence	£1000
Preparation of written submissions in lieu of a hearing	£350
TOTAL	£1,850

89. I therefore order Biokern AG to pay KERN PHARMA, S.L. the sum of **£1,850**. This sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of August 2025

Daniela Ferrari

For the Registrar

⁵⁶ A considerable number of 'pages' had two, three and even four pages of content compressed and reproduced on a single paginated page of evidence. For example, Exhibit CB14 alone contains 359 pages of evidence compressed onto 89 paginated pages of evidence.